

REMARKS

1. Introduction

In the Office Action mailed February 18, 2009, the Examiner rejected claims 1, 3, 4, and 6-9 under 35 U.S.C. § 103(a) as being unpatentable over Karaoguz et al., U.S. Pub. No. 2002/0059434 (“Karaoguz”) in view of Lu et al., U.S. Patent No. 6,694,134 (“Lu”) and further in view of Mäenpää, U.S. Patent No. 5,583,916 (“Mäenpää”). The Examiner rejected claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Karaoguz in view of Lu and Mäenpää, and further in view of Thornton et al., U.S. Pub. No. 2002/0101860 (“Thornton”).

In response, Applicants have amended claim 1 and added new claim 20. Thus, claims 1, 3, 4, 6-11, and 20 are currently pending.

For the reasons set forth below, Applicants request reconsideration and allowance of the application, as amended herein.

2. Response to the Claim Rejections

Of the claims currently pending, claim 1 is independent. The Examiner has rejected claim 1 under § 103(a) as being unpatentable over Karaoguz in view of Lu and further in view of Mäenpää. Applicants submit that the rejection of claim 1 is clearly erroneous and should be withdrawn because the Karaoguz/Lu/Mäenpää combination does not teach each and every element of claim 1, as set forth below.

Claim 1 recites, *inter alia*, “a second data register co-located with said PBX ... wherein said second data register stores a second data record for said multi-mode mobile station when said multi-mode mobile station operates in said second wireless coverage area.” The Examiner

has admitted that Karaoguz and Lu, in combination, fail to teach this element. *See* Office Action, p. 4. Instead, the Examiner relied on Mäenpää, specifically citing col. 7, lines 55-59 as allegedly teaching a second data register co-located with a PBX. *Id.*

However, the Examiner has misread Mäenpää. The section cited by the Examiner refers to a home subscriber database 405 that is provided in a VLR *connected* to the home PBX:

In the invention, a home subscriber database 405 is provided in the visitor location register VLR connected to the home PBX, consisting of the identifiers of those subscribers which have a given PBX located within the service area of said VLR as their home location area.

See col. 7, lines 55-59. Thus, home subscriber database 405 is *connected* to the home PBX, not *co-located* with the PBX, as recited in claim 1. Moreover, as Figure 4 makes clear, the VLR containing home subscriber database 405 is not even directly connected to the home PBX. Instead, the home PBX communicates with home subscriber database 405 via an MSC. *See* Figure 4 and col. 8, lines 10-20. As a result, Mäenpää does not make up for the admitted failure of Karaoguz and Lu to teach a second data register that is *co-located* with a PBX, as recited in claim 1.

Although the Examiner's rejection of claim 1 based on the Karaoguz/Lu/Mäenpää combination is clearly erroneous, Applicants have amended claim 1 to specify that the first data register is a home location register (HLR), in order to expedite prosecution. This amendment is supported by Applicants' specification, for example, at page 6, line 9 – page 7, line 14 and page 9, line 18 – page 10, line 3. In rejecting claim 1, the Examiner alleged that Karaoguz teaches “a first data register that contains a first data record for multi-mode mobile station,” specifically citing to Figure 2 and to paragraph 38. *See* Office Action, p. 3. However, neither Figure 2 nor paragraph 38 discloses an HLR.

Accordingly, Applicants submit that claim 1, as amended, is clearly allowable over Karaaguz, Lu, and Mäenpää for at least the foregoing reasons. Applicants further submit that claims 3, 4, 6-11, and 20 are allowable as depending from an allowable claim.

3. Conclusion

Applicants submit that the present application is in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, the Examiner is invited to telephone the undersigned at any time at (312) 913-0001.

Respectfully submitted,

Dated: May 15, 2009

By: Richard A. Machonkin
Richard A. Machonkin
Reg. No. 41,962